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HEWLETT-PACKARD COMPANY  
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EXAMINER
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WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/905,579

Applicant(s)

CHOW, CARL S.

Examin r

Richard Woo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

- 1) Claims 12-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2) Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of

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whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it

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"enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in

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*State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In this present application, a method of distributing literature in the form of a booklet which includes a plurality of sheets of media (with respect to Claims 1 and 7) does not include any computer implementation or any other technology employed.

### ***Claim Objections***

3) Claims 8-10 are objected to because of the following informalities:

In Claim 8, line 4, "etc." should be deleted.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5) Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US 5,134,568).

**W.R.T. Claim 1:**

Tonkin discloses a method comprising:

counting the number of sheets of media in the booklet (col. 9, line 52 – col. 10, line 3);

estimating the weight of each sheet of media (*Id.*); and

multiplying the number of sheets of media in the booklet by the estimated weight of each sheet of media to calculate the total weight of the media (see generally cols. 9-10).

**W.R.T. Claims 2-6:**

Tonkin further discloses the method comprising:

estimating the weight of the binding materials or cover (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9); and

adding the weight of the binding materials and the total weight of the media (*Id.*);

calculating postage for the booklet based on the total weight of the media (including additional materials) (see Fig. 9 and col. 13, line 26 – col. 14, line 34).

***Claim Rejections - 35 USC § 103***

6) Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin in view of EP 0621563 A1 (hereinafter EP).

**W.R.T. Claim 7:**

Tonkin discloses a method comprising:

calculating the weight of the booklet by multiplying the number of sheets of media which are used in the booklet by the estimated weight of each sheet of media (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9); and

calculating a postage for media based on the weight of the booklet.

However, Tonkin does not expressly disclose the method including:  
printing the postage on the booklet.

EP teaches, for system and method for preparing items for mailing, that the system prints the postage on the booklet, wherein the postage amount is calculated by the known weights of the selected items.

Since EP and Tonkin are both from the same field of endeavor of printing items with known weight and combining the items to calculate the total weight, the purpose disclosed by EP would have been well recognized in the pertinent field of Tonkin.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to print the postage on the booklet of Tonkin, as taught by EP, for the purpose of providing a proper postage based on the total weight of the booklet so as to be ready for immediate delivery.



**W.R.T. Claims 8-11:**

The modified method of Tonkin further discloses the method comprising:

- receiving a client inquiry (see Figs. 5A-9 of Tonkin);
- prompting the client for a name and address in response to the client inquiry (*Id.*);
- receiving a name and address from the client in response to the prompt (*Id.*);
- sending a literature selection prompt signal to the client via the communication link in response to receiving the name and address data signal (see *Supra*);
- receiving a literature selection data signal from the client via the communication link in response to receiving the selection data signal (see Figs. 5A-9 and the descriptions thereof);
- sending a finish command prompt signal to the client (*Id.*);
- receiving a command signal from the client and wherein the weight of the booklet is calculated in response to receiving the command signal (col. 8, line 49, - col. 10, line 3; see Figs. 5A-9 of Tonkin);
- assembling selected literature in response to the receiving the finish command signal (*Id.*);
- printing the selected literature (*Id.*);
- storing a name and address of a client in a memory in response to receiving the name and address data signal (see Figs. 1-3 and description thereof Tonkin);
- retrieving the name and address of the client from the memory in response to receiving the finish command signal;

printing the name and address of the client on a cover sheet of media in response to retrieving the name and address data (EP teaches the system and method that prints the name and address as well as postage on the publication);

generating a customized cover letter addressed to a client based on literature selected by the client and in response to receiving the finish command signal (see Fig. 9 of Tonkin); and

printing the cover letter on a sheet of media which is to be included in the booklet in response to generating the customized cover letter (see Fig. 9 and the description thereof, for example).

### ***Conclusion***

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Self-Publish Your Book With.." is cited to show Print –On-Demand site to take a book from client over the Internet and publish it.

EP 0782068 A1 is cited to show a remote printing system that each print order from the client is accepted, validated and stored; and files are queued for printing at a selected production plant. Upon printing, each print order is finished and shipped to the user.

US 5,143,362 is cited to show a method and system providing for the personalization of magazines and other publications, wherein recipient's name, address and other information can be printed on the publications.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
Patent Examiner  
GAU 3629  
November 14, 2003



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